Paper No. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte JURGEN MOHR and WOLF-DIETER BALZER

Appeal No. 1998-2040
Application No. 08/420,077

HEARD: March 13, 2001

Before, JOHN D. SMITH, KRATZ and TIMM, Administrative Patent Judges.

KRATZ, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's refusal to allow claims 1 and 3-6 as amended after final rejection. No other claims are pending in this application.

BACKGROUND

The appellants' invention relates to a method of recovering glycol from used antifreeze employing an alkali metal hydroxide additive and an organic solvent in the recovery process which includes a distillation step. According to appellants (specification, page 4), the alkali

metal hydroxide additive avoids nitrosamine formation in the used antifreeze. Claim 1, the sole independent claim on appeal, is reproduced below.

> A process for recovering a glycol from a used glycol-containing technical fluid, which comprises adding to the used glycol-containing technical fluid an alkali metal hydroxide and an organic solvent which forms, with the glycol, an azeotropic mixture which has a lower boiling point than the glycol itself and distilling off this azeotropic mixture, wherein the used glycol-containing technical fluid is used antifreeze.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Cox et al. (Cox)	3,878,055	Apr. 15, 1975
Chueh	4,057,471	Nov. 08, 1977

Claims 1 and 3-6 stand rejected under 35 U.S.C. § 103 as being unpatentable over Chueh in view of Cox.

OPINION

We refer to the appellants' brief and reply brief and to the examiner’s answer for the opposing viewpoints expressed by appellants and the examiner concerning the above noted rejection. For the reasons of record, as particularly set

forth in the reply brief, we determine that the aforementioned § 103 rejection is not well founded. Accordingly, we will not sustain the examiner's rejection. We add the following for emphasis.

Chueh describes a method for recovering glycol from mixtures of glycol and carboxylate esters thereof using an azeotroping agent and azeotropic distillation. The examiner does not allege that Chueh discloses the use of an alkali metal hydroxide additive in their disclosed distillation process. Rather, the examiner relies on Cox for an alleged teaching of adding alkali metal hydroxide to a spent glycol-containing fluid (answer, page 3). According to the examiner, "[o]ne having ordinary skill in the art would have been led to employ the alkali metal hydroxide of Cox et al, for the recovery of glycol, in the process of Chueh motivated by a reasonable expectation of success" (sentence bridging pages 3 and 4 of the answer). We disagree.

As developed in appellants' reply brief, neither of the applied references alone or in combination teaches or suggests the addition of an alkali metal hydroxide additive to used

antifreeze in a process of recovering glycol therefrom. While Cox discloses the addition of a small amount of alkali metal hydroxide to spent glycol[1] containing dimethyl terepthalate impurities for catalyzing a reaction thereof with glycol (paragraph bridging columns 3 and 4), the examiner has not established where Cox alone or in combination with Chueh teaches or suggests the use of such alkali metal hydroxide addition in recovering glycol from used antifreeze. In this regard, a need for catalyzing a reaction of dimethyl terepthalate in used antifreeze is not apparent on this record.

The mere fact that the prior art may be modified to reflect features of the claims invention does not make the modification obvious unless the desirability of such modification is suggested by the prior art. The claimed invention cannot be used as an instruction manual or template to piece together the teachings of the prior art so that the

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[1] Cox defines spent glycol as "ethylene glycol recovered from processes for making and forming films and fibers of linear polyesters, particularly the high molecular weight linear polyesters made from ethylene glycol and terephthalic acid or its derivatives, such as dimethyl terepthalate" (column 1, lines 19-25).

claimed invention is rendered obvious. *See In re Fritch*, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992). Accordingly, on this record, the rejection fails for lack of a sufficient factual basis upon which to reach a conclusion of obviousness.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 and 3-6 under 35 U.S.C. § 103 as being unpatentable over Chueh in view of Cox is reversed.

REVERSED

JOHN D. SMITH Administrative Patent Judge	)
PETER F. KRATZ Administrative Patent Judge	) BOARD OF PATENT APPEALS AND INTERFERENCES
CATHERINE TIMM Administrative Patent Judge	)

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APPEAL NO. - JUDGE KRATZ
APPLICATION NO.

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DECISION: **ED**

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DRAFT TYPED: 11 Jan 02

FINAL TYPED: